

## REMARKS

### I. Introduction

Claims **67-78** are currently pending in the present application. Claims **67, 76, 77, and 78** are independent. All claims stand rejected. In particular,

(A) claims **67-78** stand rejected under 35 U.S.C. §112, first paragraph for allegedly not being enabled by the specification;

(B) claims **67** and **76-78** stand rejected under 35 U.S.C. §103(a) for allegedly being unpatentable over “TetrisAttack” in view of “Uproar”, in further view of “Tile Fall”;

(C) claims **68-70** stand rejected under 35 U.S.C. §103(a) for allegedly being unpatentable over TetrisAttack; and

(D) claims **71-75** stand rejected under 35 U.S.C. §103(a) for allegedly being unpatentable over TetrisAttack in view of Uproar.

Upon entry of this amendment, which is respectfully requested, claims **67, 70, and 76-78** will be amended and new claims **79-81** will be added, of which new claims **80 and 81** are independent. No new matter is introduced by this amendment.

Applicant hereby respectfully requests reexamination and reconsideration of the pending claims in light of the amendments and remarks provided herein and in accordance with 37 C.F.R. §1.112.

### II. Interview Summary

Initially, Applicant thanks Examiner Epshteyn and Supervisory Patent Examiner Thai for the telephone interview granted and conducted on February 1, 2006. In the interview, Applicant’s representative described how all currently claimed embodiments are consistent with and supported by the specification, and Examiner Epshteyn indicated that the §112, first paragraph rejections will be re-examined for applicability.

Applicant’s representative also related how none of the cited references teach or suggest “revealing” secondary game rules to players, particularly where such rules are “selected randomly” from a plurality of available game rules.

To advance prosecution in relation to some embodiments, as discussed in the interview, Applicant has amended the language of some claims to distinctly point out that the secondary game rule is associated with how remaining game icons “shift” within the game boundary (as opposed to “reconfiguring”). In other words, although Applicant does not believe that the prior art of record teaches or suggests “revealing” a secondary game rule to a player where the game rule is associated with “reconfiguring” game icons, Applicant nonetheless provides the current amendments to place the pending claims directed to such embodiments in more clearly apparent form for allowance than they would otherwise be (*i.e.*, to advance prosecution). Applicant currently plans on pursuing embodiments directed to such “reconfiguring” of game icons in one or more continuing applications (*e.g.*, to the extent not already covered by other pending claims herein).

### III. The Examiner’s Rejections

#### A. 35 U.S.C. §112, first paragraph

Claims 67-78 stand rejected under 35 U.S.C. §112, first paragraph for allegedly failing to comply with the enablement requirement. Applicant traverses this ground for rejection as follows.

##### 1. Test of Enablement – MPEP §2164.01

The test for enablement under 35 U.S.C. §112, first paragraph, is set forth as follows:

The standard for determining whether the specification meets the enablement requirement was cast in the Supreme Court decision of *Mineral Separation v. Hyde*, 242 U.S. 261, 270 (1916) which postured the question: is the experimentation needed to practice the invention undue or unreasonable? That standard is still the one to be applied. *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988)...The test of enablement is not whether any experimentation is necessary, but whether, if experimentation is necessary, it is undue. *In re Angstadt*, 537 F.2d 498, 504, 190 USPQ 214, 219 (CCPA 1976).

MPEP §2164.01.

Determining whether the experimentation needed to practice the invention is undue requires an analysis of various factors, described as follows:

There are many factors to be considered when determining whether there is sufficient evidence to support a determination that a disclosure does not satisfy the enablement requirement and whether any necessary experimentation is "undue." These factors include, but are not limited to:

- (A) The breadth of the claims;
- (B) The nature of the invention;
- (C) The state of the prior art;
- (D) The level of one of ordinary skill;
- (E) The level of predictability in the art;
- (F) The amount of direction provided by the inventor;
- (G) The existence of working examples; and
- (H) The quantity of experimentation needed to make or use the invention based on the content of the disclosure.

*In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988)...

It is improper to conclude that a disclosure is not enabling based on an analysis of only one of the above factors while ignoring one or more of the others. The examiner's analysis must consider all the evidence related to each of these factors, and any conclusion of nonenablement must be based on the evidence as a whole. 858 F.2d at 737, 740, 8 USPQ2d at 1404, 1407.

MPEP §2164.01(a).

## **2. *Prima Facie* Case of Non-Enablement**

"In order to make a rejection, the examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention. *In re Wright*, 999 F.2d 1557, 1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993) (examiner must provide a reasonable explanation as to why the scope of protection provided by a claim is not adequately enabled by the disclosure)". MPEP §2164.04; emphasis added.

The nature of the arguments and evidence required for the Examiner to meet this initial burden are described as follows:

According to *In re Bowen*, 492 F.2d 859, 862-63, 181 USPQ 48, 51 (CCPA 1974), the minimal requirement is for the examiner to give reasons for the uncertainty of the enablement... The language should focus on those factors, reasons, and evidence that lead the examiner to conclude that the specification fails to teach how to make and use the claimed invention without undue experimentation, or that the scope of any enablement provided to one skilled in the art is not commensurate with the scope of protection sought by

the claims. This can be done by making specific findings of fact, supported by the evidence, and then drawing conclusions based on these findings of fact.

MPEP §2164.04

### **3. The Examiner's Case as Set Forth**

The Examiner states that “[t]he specification, while being enabling for a reconfiguration rule to be applied to the player is not indicated to the player, does not reasonably provide enablement for a reconfiguration rule to be applied during the game move that is indicated to the player.” Office Action mailed December 1, 2005, pg. 2, bullet two.

### **4. No *Prima Facie* Case for Non-Enablement**

Applicant respectfully submits that the specification, as filed, contains substantial support for concepts relating to both the concealment and revealing of game rules. Applicant believes that this ground for rejection is based on a simple misunderstanding of the pending claims, which appears to have been remedied by the above-mentioned interview. Applicant notes, for example, that the step of “revealing” a game rule necessarily implies that the game rule was theretofore hidden, concealed, or otherwise not known or made available to the player. Nowhere does the Examiner indicate how it is believed that undue experimentation would be required for one of ordinary skill in the art to practice the claimed embodiments.

At least for these reasons, Applicants hereby respectfully request that the §112, first paragraph rejections of claims 67-78 be withdrawn.

#### ***B. 35 U.S.C. §103(a) – “TetrisAttack”, “Uproar”, “Tile Fall”***

Claims 67 and 76-78 stand rejected under 35 U.S.C. §103(a) for allegedly being unpatentable over TetrisAttack in view of Uproar, in further view of Tile Fall. Applicant traverses this ground for rejection as follows.

## 1. Claims 67 and 76-77

Applicant respectfully submits that none of TetrisAttack, Uproar, nor Tile Fall, alone or in any combination, teach or suggest limitations of claims 67 and 76-77. None of TetrisAttack, Uproar, nor Tile Fall teach or suggest, for example, *revealing, after receiving the first game input, a second game rule to the player, wherein the second game rule indicates how removal of a game icon from within the game boundary will cause remaining game icons to **shift** within the game boundary, and wherein the second game rule is different from the first game rule.*

Applicant hereby incorporates by reference the arguments presented in previous responses (particularly those of the last Response) that describe how TetrisAttack fails to teach or suggest more than one such game rule, as claimed. Applicant further submits that Uproar simply fails to make up for the deficiencies of TetrisAttack.

While Tile Fall does utilize a second game rule, such game rule is not “revealed” to the player, nor is such a game rule associated with how icons are “shifted” within the game boundary. All game rules in Tile Fall, just like TetrisAttack, are *always* available to the player, and thus are not revealed, particularly during game play (e.g., as claimed).

Further yet, even if the references taught or suggested all claimed limitations (which Applicant submits they do not), the Examiner has not pointed to any specific motivation that would have led one skilled in the art to make any of the alleged combinations, nor has any evidence been submitted in support of such allegations.

At least for these reasons, the Examiner has failed to establish a *prima facie* case of obviousness for claims 67 and 76-77. Accordingly, Applicants respectfully request that the §103(a) rejections of claims 67 and 76-77 be withdrawn.

## 2. Claim 78

Applicant respectfully submits that none of TetrisAttack, Uproar, nor Tile Fall, alone or in any combination, teach or suggest limitations of claim 78. None of TetrisAttack, Uproar, nor Tile Fall teach or suggest, for example, *wherein the first game rule is **selected randomly** from a plurality of available game rules.*

As discussed in the above-mentioned interview, any game rules applicable to TetrisAttack or Tile Fall are static and unchanging. Nowhere does either reference contemplate randomly selecting a game rule from a pool of available game rules.

Further yet, even if the references taught or suggested all claimed limitations (which Applicant submits they do not), the Examiner has not pointed to any specific motivation that would have led one skilled in the art to make any of the alleged combinations, nor has any evidence been submitted in support of such allegations.

At least for these reasons, the Examiner has failed to establish a *prima facie* case of obviousness for claim 78. Accordingly, Applicants respectfully request that the §103(a) rejection of claims 78 be withdrawn.

***C. 35 U.S.C. §103(a) – “TetrisAttack”***

Claims 68-70 stand rejected under 35 U.S.C. §103(a) for allegedly being unpatentable over TetrisAttack. Applicant traverses this ground of rejection. Claims 68-70 are believed to be patentable at least for the reasons described in Section B above (e.g., Tetris Attack fails to teach or suggest limitations of the pending claims). Claims 68-70 are also believed to be patentable, for example, at least as depending upon a patentable base claim (claim 67).

***D. 35 U.S.C. §103(a) – “TetrisAttack”, “Uproar”***

Claims 71-75 stand rejected under 35 U.S.C. §103(a) for allegedly being unpatentable over TetrisAttack in view of Uproar. Applicant traverses this ground of rejection. Claims 71-75 are believed to be patentable at least for the reasons described in Section B above (e.g., Tetris Attack and Uproar fail to teach or suggest limitations of the pending claims, and there is no motivation to combine the references). Claims 71-75 are also believed to be patentable, for example, at least as depending upon a patentable base claim (claim 67).

#### **IV. Conclusion**

At least for the foregoing reasons, it is submitted that all claims are now in condition for allowance, *or in better form for appeal*, and the Examiner's early re-examination and reconsideration are respectfully requested.

Alternatively, if there remain any questions regarding the present application or the cited reference, or if the Examiner has any further suggestions for expediting allowance of the present application, the Examiner is cordially requested to contact Carson C.K. Fincham at telephone number 203-461-7017 or via electronic mail at [cfincham@walkerdigital.com](mailto:cfincham@walkerdigital.com), at the Examiner's convenience.

Respectfully submitted,

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Date



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